

Applicant acknowledges and thanks the Examiner for the withdrawal of the objection to claim 2, the rejection under 35 U.S.C. § 102(e) over *Knitowski*, and the rejections under 35 U.S.C. §§ 102(b) over *DesLauriers*.

II. Obviousness-type Double Patenting Rejection

Claims 1-2 and 4-28 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 6-7, 16, and 24 of copending Application No. 09/258,809 for the reasons set forth on page 2 of the present Office Action.

Applicant submits herewith a new Terminal Disclaimer to replace the Terminal Disclaimer filed October 30, 2002 which contained a typographical error. Accordingly, Applicant respectfully requests the withdrawal of this rejection.

III. Information Disclosure Statement

Applicant notes that in the initialed Information Disclosure Statement attached to PTO Paper No. 6, the Examiner drew a line through the entry reciting "Abstract 114: 108 976, XP002143304, "Film-forming Aerosol Preparations Containing ABA-type Triblock Thermoplastic Elastomers," and added "No Date" beside this listing. However, Applicant draws the Examiner's attention to the abstract, in particular to the underlined headings entitled "Date." Accordingly, Applicant respectfully requests that the Examiner initial the PTO Form 1449 beside

the recitation of this Abstract and provide Applicant with a copy of the initialed document once it has been considered by the Examiner.

IV. Rejection under 35 U.S.C. § 103(a)

Claims 1-2 and 4-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *DesLauriers* in view of *Anton*, *Konik*, or *Kimura* for the reasons set forth at pages 3-7 of the present Office Action. Applicant respectfully traverses this rejection.

Two of the basic criteria an Examiner must demonstrate in order to establish a prima facie case of obviousness are (1) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and (2) that there is a reasonable expectation of success in making the proposed modification. See M.P.E.P. § 2143. Neither of these two criteria has been satisfied with respect to the modifications of *DesLauriers* proposed by the Examiner.

With respect to the first criterion, the Federal Circuit recently reaffirmed the Examiner's high burden to establish a prima facie case of obviousness and emphasized the requirement for specificity. In *In re Lee*, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be **based on objective evidence of record**. This precedent

has been reinforced in myriad decisions, and **cannot be dispensed with.**" 61

U.S.P.Q.2D (BNA) 1430, 277 F.3d 1338, 1433 (Fed. Cir. 2002) (emphasis added).

Further, the Federal Circuit explained that

[t]he need for specificity pervades this authority...
the examiner can satisfy the burden of showing
obviousness of the combination **only by showing some**
objective teaching in the prior art or that knowledge
generally available to one of ordinary skill in the art
would lead that individual to combine the relevant
teachings of the references.

Id. (internal citations and quotation omitted) (emphasis added).

Even when obviousness is based on a single prior art reference, there must be such a showing, based on objective evidence of record, to make the specific combination that was made by the applicant. See e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000); see also B.F. Goodrich Co. v. Aircraft Braking Sys. Corp., 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996).

In the present case, the requisite objective teaching to make the specific combination that was made by Applicant is not present.

Claims 1, 2, and 4-26

Claim 1 is drawn to a composition comprising at least one linear dimethicone and at least one block copolymer film former chosen from tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, with the proviso that said composition comprises at least one tri-block copolymer film

former, wherein said at least one block copolymer film former is present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition.

DesLauriers does not teach such a composition nor does it provide the requisite motivation or suggestion, based on objective evidence of record, to make the specific combination as claimed in the present claim 1. As previously noted by Applicant, *DesLauriers* only discloses dimethicone once - in Table 11. However, the compositions in Table 11 comprise at least 2.5% by weight of at least one block copolymer. Moreover, the only composition comprising dimethicone and at least one block copolymer that did not exhibit separation comprised 2 wt% dimethicone and 4.9 wt% Kraton copolymers. If the concentration of the dimethicone was increased, and the concentration of the Drakeol 5 composition comprising the block copolymers therefore decreased, separation of the sample occurred. Further, *DesLauriers* did not even test compositions comprising less than 2.5 wt% block copolymers. Therefore, *DesLauriers* teaches away from compositions comprising dimethicone and at least one block copolymer film former present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition, as presently claimed.

In the present Office Action, the Examiner asserts that "the exact weight percentages of Table 11 are not considered...to limit the subsequent formulation of compositions...." but then asserts that "the compositions in Table 11...are meant to

show the compatibility of a gel according to the teachings of *DesLauriers* with common cosmetic ingredients....” See page 4 of the present Office Action. The Examiner’s statements are contradictory in that *DesLauriers* specifically uses the weight percentages of various components in Table 11 to demonstrate their compatibility with a gel, presumably in order to precisely simulate their compatibility in subsequent formulations. Accordingly, Applicant maintains that, based on the teachings of *DesLauriers* in Table 11 and in the absence of any objective evidence of record to the contrary, one of ordinary skill in the art would not have been motivated to increase the concentration of dimethicone and consequently decrease the concentration of the at least one block copolymer to an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition as presently claimed.

Beyond the results of *DesLauriers*’ Table 11 which teach away from the presently claimed composition, *DesLauriers* is silent with respect to dimethicone. Accordingly, there is simply no motivation or suggestion, based on objective evidence of record, to combine dimethicone and an amount ranging from 0.139% to 1.953% by weight of at least one block copolymer as presently claimed.

In the present Office Action, the Examiner also asserts that “[i]rrespective of the deficiencies of Table 11, *DesLauriers* clearly teaches the use of block copolymer blends including triblock copolymers in forming gels where the total amount of block copolymer ranges down to 1% of the composition.” See page 4 of the present Office

Action (citing col. 6, lines 3-36, and claims 1 and 10). However, *DesLauriers*' broad recitation that "[w]hen formed into gels, the mixture or blend of copolymers, will comprise about 1 to 20 wt % of the total weight" fails to satisfy the Examiner's burden to set forth specific, objective evidence suggesting the modifications proposed by the Examiner. Moreover, *DesLauriers* continues in the very next sentence to teach that "[p]referably the total weight of polymer contained in the oil will range from about 5 to 15 wt %." See col. 6, lines 36-37.

In fact, *DesLauriers* teaches away from compositions comprising "copolymer ranges down to 1% of the composition." This is evidenced at least by *DesLauriers*' examples. See e.g., Example 1 setting forth 9 compositions each comprising 5 wt % copolymer; Example 2 setting forth 12 compositions each comprising 5 wt % copolymer; Example 3 setting forth 5 compositions each comprising a total of 5 wt % copolymers, 2 compositions each comprising a total of 10 wt % copolymer, 2 compositions each comprising a total of 15 wt % copolymer, and 1 composition comprising 3.5 wt % copolymers; Example 4 setting forth 13 compositions each comprising 10 wt % copolymer(s); Example 5 setting forth 18 compositions each comprising 10 wt % copolymer(s); Example 6 setting forth compositions each comprising at least 2.5 wt % copolymers; and Example 7 setting forth compositions each comprising between 4.0 wt % and 6.0 wt % copolymers. The mere fact that references can be combined or modified does not render the resultant combination

obvious unless the prior art also suggests the desirability of the combination. See e.g., M.P.E.P. § 2143.01.

Moreover, as discussed above, nowhere, other than Table 11 (which teaches away from the presently claimed compositions), does *DesLauriers* teach or suggest the selection of dimethicone. In the present Office Action, the Examiner asserts that "*DesLauriers* clearly teaches that solvents may be used to dilute the resulting gel.... Such solvents...include silicones." See page 5 of the present Office Action (citing col. 6, lines 34-44 and claims 1 and 5). However, the mere recitation of the broad class of "silicones" in a laundry list of solvents again fails to satisfy the Examiner's burden to set forth specific, objective evidence suggesting the modifications proposed by the Examiner. The cited portion of *DesLauriers* recites that "[s]olvents which may be added to dilute the gel and form lotions and other flowable compositions comprise isopropyl myristate, isopropyl palmitate, silicones, organic esters, and the like." However, *DesLauriers* continues, in the very next sentence, to recite that "[t]he commercially available Finsolv TN™ is a particularly preferred solvent." See col. 6, lines 41-42. Significantly, this preference can be explained by Table 11, which shows that Finsolv TN™ exhibited good compatibility with a gel containing two Kraton copolymers at 2, 10 and 50 wt %. Thus, *DesLauriers* apparently relied heavily on the results set forth in Table 11.

Finally, the reference must be read as a whole, including portions that teach away from the proposed modification, such as Table 11. See e.g., M.P.E.P.

§ 2143.01. As just discussed, *DesLauriers* apparently placed great weight on the results set forth in Table 11. However, Table 11 clearly shows the incompatibility of dimethicone with a gel comprising less than 4.9 wt % copolymers.

Accordingly, Applicant maintains that *DesLauriers* teaches away from compositions comprising dimethicone and at least one block copolymer film former is present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition as presently claimed. As the cited references do not remedy the deficiencies of *DesLauriers*, Applicant respectfully requests the withdrawal of this rejection at least with respect to claims 1, 2, and 4-26.

Claim 29

Claim 29 is drawn to a composition comprising, inter alia, at least one linear dimethicone, at least one cyclic dimethicone, and at least one block copolymer film former as presently claimed, Applicant submits that one of ordinary skill in the art would not have been motivated to modify the compositions of *DesLauriers* in such a manner to arrive at such a composition.

As previously discussed, *DesLauriers* only discloses a composition comprising dimethicone in Table 11 which compares the compatibility of gels with various components but does not suggest combining the tested components, such as cyclomethicone and dimethicone. As noted by the Examiner, Applicant maintains that, of the emollients tested, cyclomethicone and dimethicone were the

worst. Accordingly, Applicant maintains that one of ordinary skill in the art would not have been motivated to combine these two components, at least because they are disclosed to be the worst emollients in terms of sample separation.

In the present Office Action, the Examiner asserts that “[o]n the contrary, cyclomethicone is given positive ratings in both viscosity and esthetics.” See page 5 of the present Office Action. Applicant acknowledges the positive ratings in Table 17 but asserts that these ratings cannot and do not negate the observations regarding separation reported in Table 11. Table 11 clearly reports that dimethicone and cyclomethicone were the two worst emollients in terms of compatibility with the sample gel.

The Examiner asserts that the poor compatibility results of Table 11 reported for dimethicone and cyclomethicone “teach[] that the block copolymer gels are positively compatible with a wide variety of cosmetic components, including dimethicone.” See page 6 of the present Office Action. Even using such an interpretation, there is still no motivation based on the objective evidence of record to select and combine both dimethicone and cyclomethicone, given that these are reported to be the two emollients least compatible with the gel.

The Examiner’s reliance on *Anton* for the teaching of “cosmetic sticks preferably comprising 10-40% cyclomethicone and 10-30% dimethicone” is irrelevant and wholly ignores the issue at hand - namely, the lack of motivation to select and combine both dimethicone and cyclomethicone with block copolymer(s)

in the face of *DesLaurier's* teaching of their relative incompatibility with gels containing block copolymers. *Anton's* compositions do not comprise a block copolymer and thus this reference does not and cannot negate *DesLaurier's* teaching of relative incompatibility with gels containing block copolymers.

For at least this reason, Applicant submits that neither *DesLauriers* alone or in combination with the cited secondary references render obvious the subject matter of claim 29.

Claims 27 and 28

Claims 27 and 28 are drawn to compositions and the use thereof comprising at least one linear dimethicone, at least one cosmetic powder, and at least one block copolymer film former according to the present invention. *DesLauriers* does not teach such a composition nor does it provide the requisite motivation or suggestion, based on objective evidence of record, to make the specific combination as claimed in claims 27 and 28. As previously noted, *DesLauriers* only discloses dimethicone once - in Table 11. However, the results of Table 11 clearly disclose that, in terms of the compatibility tests, not only is dimethicone the worst emollient but it is also one of three worst components tested. Applicants maintain that the objective evidence of record fails to support the proposed selection of dimethicone.

In the present Office Action, the Examiner asserts that this "argument is not convincing in light of claim 5, which specifically claims silicones." See page 6 of the present Office Action. The Examiner continues, asserting that "[s]ince the only examples of silicones presented by *DesLauriers* are dimethicone and cyclomethicone, one of ordinary skill in the art would be especially pointed in the direction of those two components as preferred species of silicones...." *Id.* This reasoning fails to satisfy the Examiner's high burden to establish a prima facie case of obviousness and to set forth specific, objective evidence suggesting the modifications proposed by the Examiner.

As discussed above, the mere recitation of the broad class of "silicones" in a laundry list of solvents is not specific objective evidence sufficient to satisfy the Examiner's burden. Further, also discussed above, *DesLauriers* continues, in the very next sentence, to recite that "[t]he commercially available Finsolv TN™ is a particularly preferred solvent." See col. 6, lines 41-42. Significantly, this preference can be explained by Table 11, which shows that Finsolv TN™ exhibited good compatibility with a gel containing two Kraton copolymers at 2, 10 and 50 wt %. Thus, *DesLauriers* apparently relied heavily on the results set forth in Table 11.

Further, as acknowledged by the Examiner, *DesLauriers* sets forth two species of silicones. Table 11 teaches that cyclomethicone is relatively more compatible with the gel of *DesLauriers* than is dimethicone. Moreover, Table 17 reports favorable results for cyclomethicone. Thus, the Examiner has provided no

objective evidence of record to support his implied assertion that one of ordinary skill in the art would have been motivated to select dimethicone at all, let alone in lieu of cyclomethicone.

Moreover, nowhere does *DesLauriers* teach or suggest at least one cosmetic powder. Neither the broad recitation of "various health and beauty aid compositions" nor the recitation of "lipstick" relied on by the Examiner satisfy his burden of providing specific, objective evidence to support the proposed combinations and selections.

Finally, the Examiner's rejection is based on piecing together unrelated bits and pieces of *DesLauriers*' disclosure and the Examiner fails to provide any motivation for bringing together these bits and pieces. As discussed, *DesLauriers* mentions dimethicone only once - in Table 11 - and this table shows that it is the worst of the emollients tested in terms of sample separation. Further, *DesLauriers* does not mention at least one cosmetic powder. The Examiner has failed to provide any motivation for piecing together these bits. Accordingly, Applicant maintains that the Examiner has failed to establish a prima facie case of obviousness and respectfully requests the this rejection be withdrawn at least with respect to claims 27 and 28.

Claim 31

Claim 31 is drawn to a composition comprising at least one linear dimethicone in an amount ranging from 25% to 75% by weight relative to the total weight of the composition and at least one block copolymer film former according to the present invention. Applicant maintains that one of ordinary skill in the art would not have been motivated to modify the compositions of *DesLauriers* in such a manner necessary to arrive at the compositions of claim 31.

As discussed above, *DesLauriers* teaches in its sole disclosure of dimethicone that compositions comprising greater than 2 wt% dimethicone result in sample separation. See Table 11. Accordingly, *DesLauriers* teaches away from compositions comprising greater than 2 wt% dimethicone. However, the compositions of claim 31 comprise, inter alia, at least one linear dimethicone in an amount ranging from 25% to 75% by weight relative to the total weight of the composition.

For at least the foregoing reason, Applicant submits that one of ordinary skill in the art would not have been motivated to modify the compositions of *DesLauriers* in such a manner necessary to arrive at the compositions of claim 31.

V. Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-26 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner asserts that claim 1 "is confusing due to the limitation of 'wherein said at least one block copolymer film former is present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition.'" See page 7 of the present Office Action. The Examiner states that "it is unclear whether the total amount of a mixture of block copolymer film formers must be within the stated range, or whether the weight percentage of each individual block copolymer film former must be within the stated range." *Id.* Applicant disagrees and respectfully traverses this rejection.

As set forth in claim 1, the inventive composition comprises, inter alia, "at least one block copolymer film former...wherein said at least one block copolymer film former is present in an amount ranging from 0.139% to 1.953% by weight relative to the total weight of the composition." See claim 1 (emphasis added). Accordingly, the range of concentrations set forth in claim 1 refers to the total amount of the at least one block copolymer film former, i.e., of tri-block copolymer film formers, multi-block copolymer film formers and radial block copolymer film formers, in the composition.

Applicant fails to see any indefiniteness in this claim. Should the Office maintain this rejection, further clarification of the grounds for doing so are requested.

Claim 10 has been amended herein to correct the recited range of concentrations thereby rendering the objection moot.

Accordingly, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

VI. Rejection under 35 U.S.C. § 102(b)

Claim 30 has been rejected under 30 U.S.C. § 102(b) as being clearly anticipated by *DesLauriers*. Claim 30 has been deleted without prejudice or disclaimer, thereby rendering this rejection moot.

VII. Conclusion

Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Application No.: 09/717,204
Attorney Docket No. 5725.0642-00

Please grant any extension of time under 37 C.F.R. § 1.136 required to enter
this response and charge those additional fees to our Deposit Account No. 06-916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Thalia V. Warren, Reg. No. 39,064
By: *for Anthony C. Tridico*
Anthony C. Tridico
Reg. No. 45,958

Dated: April 10, 2003

Appendix

Version with markings to show changes made pursuant to 37 C.F.R. § 1.121(c)(1)(ii):

IN THE CLAIMS

--10. (Amended) The composition according to claim 1, wherein said at least one block copolymer film former is present in said composition in an amount ranging from 0.265% to 1.953% [0.139% to 4.185%] by weight. --

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com